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REMARKS

Reconsideration and allowance of the above-referenced application are respectfully requested. Upon entry of the above amendment, claims 9-20 and 29-46 will be pending with claims 9, 11, 19, 29, 31, and 39 being independent. Claims 1-8 and 21-28 have been canceled without prejudice, new claims 31-46 have been added, and claims 9, 11, 14, 19, and 29 have been amended. No new matter has been added.

Premature Final Rejections

The finality of the official action is premature and should be withdrawn for at least the reason that new grounds for rejection appear in the November 2, 2005 official action.

New grounds for rejection appear as the November official action cites new support for the rejection of claims 1-4, 8, 11-14, 18, 21-24, and 28. In particular, the November official action introduces support for the 103 rejection of these claims in the Bailey provisional, where such support was not previously relied upon in prior official actions.

An October 2004 official action includes a 103(a) rejection that relies on Bailey. In response to that official action, Bailey was mentioned as not being prior art, and, thus, as being an improper source of reliance for a rejection under section 103(a). A May 2005 official action implicitly acknowledged the improper reliance on Bailey, as many of the citations to Bailey were changed to citations of a provisional application to which Bailey relied. However, a portion of the rejection still relied on the published non-provisional application, the portion citing reference numeral 218 of FIG. 2. An August 2005 response to this official action noted the impropriety of such a citation. In what appears to be an attempt to avoid the issue, the November 2005 official action states "[t]he Office agrees that this element is not contained in Figure 2 of the Bailey provisional application asserted by Applicant, however, disclosure of the limitation is provided in the Bailey provisional application, Page 9, lines 9-14."

Not only does this cause the final office action to improperly rely on new support for a rejection under section 103(a) such that a final rejection is premature-- as the provisional was not relied upon in the earlier official action-- but, the official action confusingly finds a section of the provisional application that is not the same as the segment in the published patent application,

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and this substitution tends to obscure the premature nature of the premature final rejection. In particular, 218 of Bailey is a "UL [sic-UI] Bottom (HTML FILE)"; whereas, the provisional never discloses such files. The cited portion of the provisional discloses:

"Server 12 typically has a memory in which web pages and other information is stored. In the case of the present invention, the server is programmed with software for receiving information from the user and generating a graphic file in response to the instructions from the user. Server 12 includes various web pages that are stored in the memory of the server. Many of these web pages are interactive forms that are transmitted to the client."

How these two disclosures are supposed to relate is not discussed in the November official action and is unclear. Thus, even were a substitution between a provisional and later, non-prior art, publication acceptable, in this case, where the substitution is of two unrelated disclosures, the support differs such that the finality of the November 2005 official action is improper, and should be withdrawn.

Rejections under 35 U.S.C. § 103(a)

Claims 1-4, 6-14, 16-24, and 26-30 are rejected under 35 U.S.C. section 103(a) as allegedly being unpatentable in view of a combination of two or more of Bailey et al. (U.S. Publication 200210059278, hereafter "Bailey"; claiming priority to U.S. Provisional Application Number 601201 234, hereafter "Bailey provisional"); Chiang (U.S. Publication 200110037490, hereafter Chiang; claiming priority of U.S. Provisional Application Number 60/190364, hereafter Chiang provisional), and Guck (U.S. Patent 5,911,776, hereafter "Guck"). These rejections are traversed.

As an initial matter, although the rejections on their face still reject the claims in view of non-provisional applications of Bailey and Chiang (each of which post-date a priority date of this application), as the citations used in the official action are to provisional counterpart applications, only the provisional applications will be discussed.

The Bailey provisional discloses the use of a document template and receiving personalization information to generate a personalized document from the document template. Bailey provisional, p. 3, lines 12-19.

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The Chiang provisional discloses the use of a HTML to Web Application Generator that converts HTML files into a generic programming language. Chiang provisional, p. 2, first full paragraph.

Guck discloses software in a data base that will provide multiple sets of "shadow" file-converter groups connected to a source file of an original document. Any client or user of a network can access and receive a copy of the original source document which is automatically reformatted to match requirements of a receiver's appliance. Guck, Abstract. Thus, "shadow" files of a source document can be generated for different appliance, such as a fax machine. Guck, col. 8, lines 10-16.

Claims 31 and 39

Independent claims 31 and 39 include features directed to a combination of receiving by a web authoring tool first information to be contained in a first file, and second information characterizing one or more properties of the first information; and, storing in the first file the first information but not the second information. These features are beneficial as, for example, a web authoring tool can receive both HTML code and comments for the HTML code (e.g., in one or more user interfaces), and the comments need not be saved with the HTML code such that the comments are not published with the HTML code.

The Bailey provisional does not disclose the claimed features. For example, the Bailey provisional does not disclose a web authoring tool that receives first information to be contained in the file and receives second information characterizing the first information. As another example, the Bailey provisional does not disclose storing in a file the first information but not the second information. The document template of the Bailey provisional is not equivalent to the second file of the claims, as the document template of the Bailey provisional never stores second information in a second file that characterizes first information that includes computer source code. For example, comments to HTML code are never stored in a file distinct from the file where HTML code is stored.

In addition, the Chiang provisional does not disclose these features. There is no disclosure of a web authoring tool that receives first information to be contained in the file, including computer source code, and receives second information characterizing the first

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information that is stored in a second file. In the Chiang provisional, computer code is generated based on HTML code.

As the cited references do not disclose features of independent claims 31 and 39, these claims should be allowed.

Claims 9, 19 and 29

Independent claims 9 and 29 include features directed to, responsive to a request to retrieve a file, retrieving the file and retrieving a shadow file containing information about the file but not contained in the file. Claim 19 includes features directed to a file manager responsive to an identifier of a file received, retrieving the file and a shadow file having a filename comprising the filename of the file and containing information about the file, the information about the file not being contained in the file. The official action uses a combination of the Bailey provisional and Guck to reject these claims. This combination is improper because neither of the cited references disclose features of the amended claims, and the teachings of the references would teach a combination that is not the subject matter of the claims; thus, the rejection of these claims should be withdrawn.

Neither of the references disclose, in response to a request to retrieve a file, retrieving a shadow file containing information about the file but not contained in the file in response to a request to retrieve the file. Similarly, neither of the references disclose responsive to an identifier of a file received, retrieving the file and a shadow file having a filename comprising the filename of the file and containing information about the file, the information about the file not being contained in the file. In example implementations, the claimed features can be beneficial as a file and comments about the file that reside in a separate file can be pulled up by a web-authoring tool. By having the comments in another file (e.g., a shadow file), comments can be maintained separately such that, for example, publishing the file does not incidentally publish comments.

Further, the combination of the cited references would not have resulted in the claimed subject matter. The official action states "it would have been obvious to...include the information content in the shadow file of Bailey with the shadow file of Guck[,] [t]he motivation for doing so would have been to define the manner in which the page is to be constructed."

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However, this is insufficient motivation to combine Guck and the Bailey provisional to teach the claimed subject matter.

Guck discloses "shadow" files that store different formats of a source file. The Bailey provisional discloses the use of a document template to generate personalized pages. The citation for the motivation to combine, to "define the manner in which the page is constructed" is from the Bailey provisional. There is no reason to believe this motivation would motivate one of ordinary skill in the art to retrieve a file, and retrieve a shadow file containing information about the file but not contained in the file, in response to a request to retrieve the file.

As the cited references do not disclose features of independent claims 9, 19, and 29, and a combination of the references would not result in the claimed subject matter, these claims should be allowed.

Claim 11

Independent claim 11 includes features directed to a shadow file builder having an input coupled to the shadow file keys/values manager for receiving the information related to the file and not contained in the file, the shadow file builder for building a shadow file responsive to said information related to the file and not contained in the file and for storing in said shadow file, different from the file. The November 2005 official action fails to make a prima facie case of obviousness as the action does not even discuss where these features of the claim exist in the cited references. Even so, these features are not disclosed in the Bailey or Chiang provisional. Thus, claim 11 should be allowed.

As claims 10; 12-14 and 16-18; 20; 30; 32-38, and 41-46 depend directly, or indirectly, on claims 9, 11, 19, 29, 31, and 39, these claims should be allowed for at least the reasons stated above.

Allowable Subject Matter

Claims 5, 15, and 25 are objected to for being dependent on rejected independent claims, but would be allowable if rewritten in independent form. The objection to claims 5 and 25 has been obviated by the cancellation of these claims; however, similar allowable subject matter

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exists in new claims 35 and 43. Claim 15 has been retained and is allowable based on its independent claim, claim 11, and the additional recitations it contains.

Conclusion

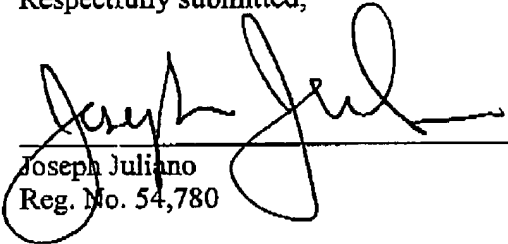
By responding in the foregoing remarks only to particular positions taken by the examiner, the applicant does not acquiesce with other positions that have not been explicitly addressed. In addition, the applicant's arguments for the patentability of a claim should not be understood as implying that no other reasons for the patentability of that claim exist.

A petition for a 3 month extension of time is requested. Please apply any charges or credits to Deposit Account No. 06 1050.

Respectfully submitted,

Date: _____

5/2/06



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